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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/075,156	02/13/2002	Heather N. Bean	10015233-1	6927

7590

06/19/2003

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EXAMINER

SHEWAREGED, BETELHEM

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 06/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/075,156

Applicant(s)

BEAN ET AL.

Examiner

Betelhem Shewareged

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 6,7 and 15-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 8-14 is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-16, drawn to print media, classified in class 428, subclass 195.
 - II. Claims 17-20, drawn to method of transferring, classified in class 156, subclass 230.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product, (e.g., providing a print media having an elastomeric sheet, an adhesive layer on the elastomeric sheet and a carrier sheet on the surface of the adhesive layer; hand writing with an ink on the surface of the elastomeric sheet; and separating the elastomeric sheet from the carrier sheet).
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. This application contains claims directed to the following patentably distinct species of the claimed invention: A: Print media having pressure sensitive adhesive

(claims 2-5 and 14); B: Print media having a dry adhesive (claims 6, 15 and 16); and C: Print media having a static force (claim 7).

5. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, 1 and 8-13 are generic.

6. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

7. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

8. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

9. During a telephone conversation with Bradley Haymond on 06/10/2003 a provisional election was made with traverse to prosecute the invention of Group I Species A, claims 2-5 and 14 along with generic claims 1 and 8-13. Affirmation of this election must be made by applicant in replying to this Office action. Claims 6, 7 and 15-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

10. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Objections

OK 11. Claim 5 is objected to because of the following informalities: In view of the specification, the pressure sensitive adhesive (PSA) remains with a printable sheet. However, it is not clear if the second sheet in claim 5 is a printable sheet or non-printable sheet. Appropriate correction is required. Currently, claim 5 is not examined, and the claim will be examined after appropriate correction is provided.

OK 12. Claim 11 is objected to because it is not clear if the first substrate in claim 11 is equivalent to the first sheet in claim 1. Appropriate correction is required.

1-5, 8-14 pend
1-3, 8-14 reje
4, 5

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 1-4, 8 and 11-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Magill et al. (US 5,813,772).

OK Magill disclose a label film composed of two elastomer layers (col. 8, lines 8 and 19). One layer is an upper layer, a layer to be imprinted and the other layer is an under layer or adhesive layer (col. 8, lines 40-46). The two layers are applied onto a release carrier strip of paper, which is a temporary support (col. 8, line 65), wherein the upper layer and the under layer are capable of being separated from the temporary support and applied onto a target material such as garment. The upper layer is equivalent to the claimed first sheet and elastomeric layer, the paper is equivalent to the claimed second sheet and carrier layer, and the release strip is equivalent to the claimed release agent. With regard to claim 11, paper is an opaque material.

15. Claims 1-4, 8-10 and 12-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Onishi et al. (US 5,955,167).

OK Onishi discloses a recording medium comprising a recording sheet, an adhesive layer on the recording sheet and a release sheet on the adhesive layer (abstract). The release sheet is designed to be peeled off from the adhesive layer and the recording

sheet (col. 2, line 53). The release sheet comprises a paper substrate and a release agent layer (col. 7, lines 46-51). The recording sheet comprises a polyester film (a polyester is an elastomer) substrate and is treated with a layer lib, which is receptive to a recording agent. The polyester film substrate is equivalent to the claimed first sheet and elastomeric layer, the layer lib is equivalent to the claimed print coating applied on the first sheet, and the paper substrate is equivalent to the claimed second sheet and carrier layer. With regard to claim 11, paper is an opaque material.

16. Claims 1, 2 and 8-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Haruta et al. (US 5,922,625).

OK

Haruta discloses a print medium comprising a backing sheet having an adhesive, and a sheet of cloth provided on the adhesive surface of the backing sheet (abstract). Polyester (a polyester is an elastomer) is used to make the cloth, and cationic substance is applied on the cloth to make the cloth printable (col. 3, line 15 thru col. 4, line 21). The backing sheet is a sheet of paper (col. 7, line 55). The cloth is equivalent to the claimed first sheet and elastomeric layer, the cationic substance is equivalent to the claimed print coating applied on the first sheet, and the backing sheet is equivalent to the claimed second sheet and carrier layer. With regard to claim 11, paper is an opaque material. The adhesive layer is designed to be peelable from the cloth and/or the backing sheet (col. 8, line 17).

Art Unit: 1774

17. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

18. Claims 1-3 and 8-14 rejected under 35 U.S.C. 102(e) as being anticipated by Mahn, Jr. (US 6,224,958 B1).


Mahn discloses a label comprising a printable rubber layer 12, and strips of pressure sensitive adhesive 18 on one side of the rubber layer, and a release sheet 20 on the pressure sensitive adhesive, wherein a coating layer 14 is applied on the other surface of the rubber layer and an indicia is printed on the coating layer (col. 2, lines 23-36). The pressure sensitive adhesive remains with the rubber layer (col. 2, line 33). The rubber layer is equivalent to the claimed first sheet and elastomeric layer, the coating layer is equivalent to the claimed print coating applied on the first sheet, and the release sheet is equivalent to the claimed second sheet and carrier layer. The release sheet (or outer removable layer) is polyester (claims 7 and 8). With regard to claim 11, polyester is either a transparent or a translucent material.

Conclusion

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is 703-305-0389. The examiner can normally be reached on Mon.-Thur. 7:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H Kelly can be reached on 703-308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-5408 for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.

BS 
06/14/2003.